

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Allan M. SCHROCK et al.

Application No.: 10/086,644

Filed: February 28, 2002

For: PACE CALCULATION WATCH

Examiner: Thanh S. Phan

Art Group: 2833

Attorney Docket No.: 005127.00197

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDED APPEAL BRIEF

Sir:

In response to the Order Returning Undocketed Appeal To Examiner mailed on May 2, 2006, as well as the Communication Re: Appeal dated May 16, 2007, Applicants respectfully submit this Amended Appeal Brief for the above identified application, and request that this appeal be reinstated. This Amended Appeal Brief constitutes the original Appeal Brief filed April 15, 2005, with an additional Related Proceedings Appendix attached thereto, as required by the above-identified Communications from the Board and the Examiner.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: June 18, 2007

1100 13th Street N.W., 12th Floor
Washington, D.C. 20005
(503) 425-6800

\William F. Rauchholz\

William F. Rauchholz
Registration No. 34,701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

<i>In re</i> Application of)	
)	
Allan M. SCHROCK ET AL.)	Group Art Unit: 2859
)	
Serial Number 10/086,644)	Examiner: Thanh S. Phan
)	
Filed: February 28, 2002)	Attorney Reference: 005127.00197
)	
For: PACE CALCULATION WATCH)	

APPEAL BRIEF

Commissioner for Patents
U.S. Patent and Trademark Office
Alexandria, VA 22313

Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from a decision of the Primary Examiner finally rejecting claims 1-51 in the above-captioned patent application.

(1) Real Party In Interest

The real party in interest is Nike Corporation, a U.S. corporation having a place of business in Beaverton, Oregon.

(2) Related Appeals and Interferences

Appellants and their legal representatives are unaware of any appeals or interferences related to the subject appeal.

(3) Status of Claims

Claims 1-51 (reproduced for reference in the Claims Appendix) are pending in the application, with claims 1, 13, 27, and 41 being independent claims. In a final Office Action

dated August 13, 2004, the Primary Examiner rejected each of claims 1-51. Specifically, the Primary Examiner rejected claims 9, 15, 30, and 44 under 35 U.S.C. §112, second paragraph, while claims 1-8, 10-14, 16-29, 31-43 and 45-51 under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki. The Primary Examiner then additionally rejected claims 9, 15, 30 and 44 over the combination of the Thinesen and Kanzaki patents, in further view of U.S. Patent No. 5,771,399 to Fishman.

With respect to the rejection of claims 9, 15, 30, and 44 under 35 U.S.C. §112, second paragraph, the Examiner indicated during a personal interview on December 20, 2004, that this “rejection is inadequate and will be withdrawn.” (See Interview Summary Record dated December 20, 2004, included in the Evidence Appendix). Accordingly, Appellants present this Brief with the understanding that the rejection under 35 U.S.C. §112, second paragraph, is withdrawn, and Appellants therefore appeal the rejections of claims 1-51 under 35 U.S.C. §103.

(4) Status of Amendments

No amendments have been made to the claims following the final Office Action of August 13, 2004.

(5) Summary Of Claimed Subject Matter

The claimed subject matter relates to a device for calculating a pace. The device includes a chronograph for measuring an elapsed time. (See, e.g., the specification of the application, pages 3-4, paragraphs 12-13). As discussed in the specification, the elapsed time is a time that has elapsed while the user is traveling a desired distance (page 11, paragraph 33). Thus, the claims recite a memory for storing a time that has already occurred. The device also includes a distance memory that stores a distance (*Id.*, page 5, paragraph 15). More particularly, the user enters the distance that the user will be running into the distance memory. (*Id.*, page 8, paragraph 24 to page 9, paragraph 28). Still further, the device also provides a pace calculation process. The recited pace calculation process calculates a pace by dividing the distance contained in the distance memory by the elapsed time provided by the chronograph. (*Id.*, page 11, paragraph 34 to page 12, paragraph 35).

(6) Grounds Of Rejection To Be Reviewed On Appeal

The following grounds of rejection are presented to the Board of Patent Appeals and Interferences for review in this appeal:

- (a) Claims 1-8, 10-14, 16-29, 31-43 and 45-51 have been rejected under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki.
- (b) Claims 9, 15, 30 and 44 have been rejected under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki, in further view of U.S. Patent No. 5,771,399 to Fishman

(8) Arguments

The Primary Examiner rejected claims 1-8, 10-14, 16-29, 31-43 and 45-51 under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki. Appellants respectfully traverse this rejection, and courteously asks for its reversal.

Each of claims 1-51 recites the determination of a pace by dividing a distance stored in memory by an elapsed time or a segment of an elapsed time. As described in the specification, the elapsed time is a time period that has already occurred, not a predicted or future time period. Accordingly, the determination of a pace as recited in these claims is not taught or suggested by either Thinesen patent or the Kanazaki patent.

With regard to the Thinesen patent, this patent describes establishing a pace by actuating command buttons in synchronism with the user's footsteps. (See, e.g., column 2, lines 11-14, column 7, lines 38-41, column 8, lines 3-10, etc.). In addition, this patent describes that the pace reflects the number of a user's steps per minute, not upon a distance traveled. (See, e.g., column 6, lines 31-58.) Appellants note that the Thinesen patent does describe a technique of multiplying this type of pace by another value, in order to convert it into a unit of distance per time. This technique, however, does not employ a stored distance and a stored elapsed time, as expressly recited in the claims.

The Kanzaki patent discloses determining a pace using a number of alternate techniques, but this patent still does not teach or suggest determining a pace as recited in the claims. First, Kanzaki discloses calculating a target pace at which a user would need to run in order to travel a distance in a target time. (See, e.g., column 8, lines 55-58, column 17, lines 4-20, etc.) Thus, this

type of “target” pace cannot be determined based upon an elapsed time. Kanzaki also discloses determining a pace by keying in pace data through a key switch. (See, e.g., column 6, lines 56-57.) Again, this portion of the Kanzaki patent does not teach or suggest determining a pace using an elapsed time. Still further, the Kanzaki patent discloses determining a pace by receiving signals from a pedometer. (See column 12, line 61 to column 13, line 25.) Accordingly, the Kanzaki patent does not teach or suggest the features of the invention recited in any of claims 1-51. The Examiner has specifically noted that the Kanzaki patent discloses the general formula for calculating pace as:

$$p=d\div w\div t$$

Appellants respectfully point out, however, that the Kanzaki patent describes using this formula to determine a desired paced based upon a target run time. It does not teach or suggest using an elapsed time to determine an actual pace, as recited in the claims.

Moreover, Appellants respectfully point out that one of ordinary skill in the art would not have been led to combine the teachings of the Kanzaki patent with the teachings of the Thinesen patent in the manner asserted by the Primary Examiner. The Kanzaki patent is directed to determining a desired pace for someone to run. The Thinesen patent, on the other hand, is directed to a device for synchronizing a pace produced by the device with the user’s actual pace. Thus, in addition to not teaching the features of the invention, the combination of the Thinesen patent with the Kanzaki patent suggested by the Primary Examiner would vitiate the very teachings of the Thinesen patent.

Appellants therefore submit that one of ordinary skill in the art would not have been led to combine the Thinesen and Kanzaki patents in the manner proposed by the Primary Examiner, and, further, that no combination of the Thinesen and Kanzaki patents would teach or suggested the invention as recited in any of claims 1-51. Appellants therefore again request that the rejection of claims 1-8, 10-14, 16-29, 31-43 and 45-51 under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki be reversed.

The Primary Examiner also rejected claims 9, 15, 30 and 44 over the combination of the Thinesen and Kanzaki patents, in further view of U.S. Patent No. 5,771,399 to Fishman. As explained in detail above one of ordinary skill in the art would not have been led to combine the Thinesen and Kanzaki patents in the manner suggested by the Primary Examiner. Further, no combination of the Thinesen and Kanzaki patents would teach or suggest the invention as recited

in any of claims 1-51. It is respectfully submitted that the Fishman patent does not remedy the omissions of the Thinesen and Kanzaki patents. Appellants therefore ask that the rejection of claims 1-51 be reversed as well.

(9) Conclusion

The rejections submitted in the final Office Action of August 13, 2004 should be reversed for at least the reasons recited above. Allowance of claims 1-51 is, therefore, respectfully requested.

A Petition For A Three Month Extension Of Time is being concurrently with this Appeal Brief. The Commissioner is authorized to charge the associated fees of:

- (a) \$500.00 for the filing of this Appeal Brief; and
- (b) \$1020.00 for the Petition For Extension Of Time

to deposit account number 19-0733. It is believed that no additional fees are due in connection with this Appeal Brief. Should additional fees be deemed necessary, however, such fees are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fees.

Respectfully submitted,

By: Thomas L. Evans
Thomas L. Evans
Registration No. 35,805

Banner & Witcoff, Ltd.
1001 G Street, N.W.
Washington, D.C. 20001-4597
Telephone: (202) 824-3000

Dated: April 15, 2005

CLAIMS APPENDIX

1. (Previously Presented) A device for calculating a pace, comprising:
a chronograph for measuring an elapsed time;
a distance memory containing a distance; and
a pace calculation process which calculates the pace by dividing the distance contained in the distance memory by the elapsed time provided by the chronograph.
2. (Original) The device recited in claim 1, further comprising a display which displays the calculated pace.
3. (Original) The device recited in claim 1, further comprising a chronometer.
4. (Original) The device recited in claim 1, further comprising an input device that allows a user to input the distance into the distance memory.
5. (Previously Presented) The device recited in claim 4, wherein the input device includes at least one depressable button.
6. (Previously Presented) The device recited in claim 5, wherein the input device includes a first depressable button for selecting a data field, a second depressable button for incrementing a value in a selected data field, and a third depressable button for decrementing the value in the selected data field.
7. (Previously Presented) The device recited in claim 1, wherein the chronograph is implemented using a mechanical structure.
8. (Previously Presented) The device recited in claim 7, further including an optical encoder for converting an elapsed time measured by the chronograph into a digital format.
9. (Previously Presented) The device recited in claim 1, wherein the chronograph, the distance memory, and the pace calculation process are incorporated into a personal digital assistant.
10. (Previously Presented) The device recited in claim 1, wherein the chronograph, the distance memory, and the pace calculation process are incorporated into a watch.
11. (Previously Presented) The device recited in claim 10, wherein the watch is a wristwatch.
12. (Previously Presented) The device recited in claim 1, further including a data memory for storing the calculated pace.

13. (Previously Presented) A method of calculating a pace with a pace calculation device, comprising:

- receiving a distance into a distance memory of a pace calculation device;
- measuring an elapsed time with a chronograph; and
- dividing the distance contained in the distance memory by the elapsed time provided by the chronograph to calculate a pace.

14. (Previously Presented) The method recited in claim 13, further comprising displaying the calculated pace to a user of the pace calculation device.

15. (Previously Presented) The method recited in claim 13, further comprising providing the calculated pace to another device.

16. (Previously Presented) The method recited in claim 13, wherein receiving the distance into the distance memory includes:

- receiving input selecting a numerical value; and
- receiving input selecting a distance unit from among a plurality of distance units.

17. (Previously Presented) The method recited in claim 16, wherein the plurality of distance units include two or more selected from the group consisting of kilometers, miles, yards, meters, feet, and nautical miles.

18. (Previously Presented) The method of claim 13, further comprising:
measuring a second elapsed time with the chronograph that is a segment of a larger elapsed time measured by the chronograph;

- determining a portion of the distance corresponding to the second elapsed time; and
- calculating a pace for the portion of the distance.

19. (Previously Presented) The method recited in claim 13, further comprising:
measuring a plurality of split times with the chronograph, each split time being a segment of the elapsed time;

- determining the number of measured split times;
- dividing the distance by the determined number of measured split times to obtain a segment distance; and

- dividing the segment distance by at least one of the measured split times to calculate a pace corresponding to the at least one of the measured split times.

20. (Previously Presented) The method recited in claim 19, further comprising dividing the segment distance by each of the measured split times to calculate a pace corresponding to each of the measured split times.

21. (Previously Presented) The method recited in claim 13, wherein the distance is received into the distance memory from an input device having at least one depressable button.

22. (Previously Presented) The method recited in claim 21, further comprising detecting actuation of a first depressable button of the input device for selecting a data field, detecting actuation of a second depressable button of the input device for incrementing a value in a selected data field, and detecting actuation of a third depressable button of the input device for decrementing the value in the selected data field.

23. (Previously Presented) The method recited in claim 1, further comprising receiving the distance into the distance memory before measuring the elapsed time.

24. (Previously Presented) The method recited in claim 1, further comprising receiving the distance into the distance memory after measuring the elapsed time.

25. (Previously Presented) The method recited in claim 1, further comprising receiving the distance into the distance memory while measuring the elapsed time.

26. (Previously Presented) The method recited in claim 1, further comprising saving the calculated pace into a data memory.

27. (Previously Presented) A method of calculating a pace, comprising:
inputting a distance into a distance memory of a pace calculation device;
prompting the pace calculation device to measure an elapsed time; and
prompting the pace calculation device to calculate a pace by dividing the distance by the elapsed time.

28. (Previously Presented) The method recited in claim 27, wherein inputting the distance into the distance memory prompts the pace calculation device to calculate the pace.

29. (Previously Presented) The method recited in claim 27, further comprising prompting the pace calculation device to display the calculated pace.

30. (Previously Presented) The method recited in claim 27, further comprising prompting the pace calculation device to provide the calculated pace to another device.

31. (Previously Presented) The method recited in claim 27, wherein inputting the distance into the distance memory includes:

selecting a numerical value; and

selecting a distance unit from among a plurality of distance units.

32. (Previously Presented) The method recited in claim 31, wherein the plurality of distance units include two or more selected from the group consisting of kilometers, miles, yards, meters, feet, and nautical miles.

33. (Previously Presented) The method of claim 27, further comprising:

prompting the pace calculation device to measure a second elapsed time that is a segment of a larger elapsed time; and

prompting the pace calculation device to

determine a portion of the distance corresponding to the second elapsed time; and

calculate a pace for the portion of the distance.

34. (Previously Presented) The method recited in claim 27, further comprising:

prompting the pace calculation device to measure a plurality of split times with the chronograph, each split time being a segment of the elapsed time; and

prompting the pace calculation device to

determine the number of measured split times;

divide the distance by the determined number of measured split times to obtain a segment distance; and

divide the segment distance by at least one of the measured split times to calculate a pace corresponding to the at least one of the measured split times.

35. (Previously Presented) The method recited in claim 34, further comprising prompting the pace calculation device to divide the segment distance by each of the measured split times to calculate a pace corresponding to each of the measured split times.

36. (Previously Presented) The method recited in claim 27, further comprising inputting the distance into the distance memory using an input device having at least one depressable button.

37. (Previously Presented) The method recited in claim 36, further comprising

actuating a first depressable button of the input device to select a data field,

actuating a second depressable button of the input device to incrementing a value in the selected data field, and

actuating a third depressable button of the input device to decrement the value in the selected data field.

38. (Previously Presented) The method recited in claim 27, further comprising inputting the distance into the distance memory before prompting the pace calculation device to measure the elapsed time.

39. (Previously Presented) The method recited in claim 27, further comprising inputting the distance into the distance memory after prompting the pace calculation device to measure the elapsed time.

40. (Previously Presented) The method recited in claim 27, further comprising inputting the distance into the distance memory while the pace calculation device is measuring the elapsed time.

41. (Previously Presented) A method of calculating a pace with a pace calculation device, comprising:

receiving a distance into a distance memory of a pace calculation device;

measuring a plurality of split times with the pace calculation device, each split time being a segment of a total elapsed time;

determining the number of measured split times;

dividing the distance by the determined number of measured split times to obtain a segment distance; and

dividing the segment distance by at least one of the measured split times to calculate a pace corresponding to the at least one of the measured split times.

42. (Previously Presented) The method recited in claim 41, further comprising dividing the segment distance by each of the measured split times to calculate a pace corresponding to each of the measured split times.

43. (Previously Presented) The method recited in claim 41, further comprising displaying the calculated pace to a user of the pace calculation device.

44. (Previously Presented) The method recited in claim 41, further comprising providing the calculated pace to another device.

45. (Previously Presented) The method recited in claim 41, wherein receiving the distance into the distance memory includes:

receiving input selecting a numerical value; and

receiving input selecting a distance unit from among a plurality of distance units.

46. (Previously Presented) The method recited in claim 45, wherein the plurality of distance units include two or more selected from the group consisting of kilometers, miles, yards, meters, feet, and nautical miles.

47. (Previously Presented) The method recited in claim 41, wherein the distance is received into the distance memory from an input device having at least one depressable button.

48. (Previously Presented) The method recited in claim 47, further comprising detecting actuation of a first depressable button of the input device for selecting a data field, detecting actuation of a second depressable button of the input device for incrementing a value in a selected data field, and detecting actuation of a third depressable button of the input device for decrementing the value in the selected data field.

49. (Previously Presented) The method recited in claim 41, further comprising receiving the distance into the distance memory before measuring the split times.

50. (Previously Presented) The method recited in claim 41, further comprising receiving the distance into the distance memory after measuring the split times.

51. (Previously Presented) The method recited in claim 41, further comprising saving the calculated pace into a data memory.

EVIDENCE APPENDIX

Interview Summary

Application No.

10/086,644

Applicant(s)

SCHROCK ET AL.

Examiner

Thanh S Phan

Art Unit

2841

All participants (applicant, applicant's representative, PTO personnel):

(1) Thanh S Phan.

(3) _____

(2) Tom Evans.

(4) _____

Date of Interview: 20 December 2004.

Type: a) ☐ Telephonic b) ☐ Video Conference
c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____

Claim(s) discussed: _____

Identification of prior art discussed: Thinesen [US 5,050,141] and Kanzake [US 5,526,290].

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: It was agreed that the 112 rejection is inadequate and will be withdrawn. Discussed newly added wording in the next response in term of patentability. Examiner will consider these arguments when the next response is received.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Related Proceedings Appendix

There are no related proceedings.